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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,109	04/08/1999	KOICHI SATO	P17387	7068

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EXAMINER
NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
2612	

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/288,109	Applicant(s) SATO, KOICHI	
	Examiner LUONG T NGUYEN	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 5/28/2003 have been fully considered but they are not persuasive.

In re pages 6-7, Applicant argues that Nakamura fails to disclose or suggest that both the photographing operation and the reproducing operation are performable by both the camera and the printer, as specified in Applicant's independent claims 1 and 16.

In response, it is noted that the feature "both the photographing operation and the reproducing operation are performable by both the camera and the printer," is not recited in claim 1. Instead, the Applicant amended claim 1 with the limitation "said image data generating processor being activated, in said photography mode, in accordance with a first operation by **one of said** image data generating start mechanism and a printing operation start mechanism associated with said printer, so that said still video camera carries out said photographing operation, said image data transmitting processor being activated, in said reproduction mode by **one of** said image data generating start mechanism and said printing operation start mechanism, so that said printer carries out said printing operation." The Examiner considers that claim 1 as amended still do not distinguish from Nakamura patent. In addition, the Applicant recites the alternative limitation "one of" in the limitation "one of said image data generating start mechanism and a printing operation start mechanism." Therefore, the prior art can only read on limitation "said image data generating start mechanism" or limitation "a printing operation start

mechanism". In this case, Nakamura discloses the first push-button 13 can take the image and print the image (figure 1, column 3, lines 23-55).

In re pages 6-7, Applicant argues that the applied art of record does not disclose the feature "when release switch 101 (or print start switch 214) is manipulated a first time, a first operation (such as, for example, the photography operation) is performed. When the release switch 101 (or print start switch 214) is manipulated a second time (or, alternatively, depressed continuously for a predetermined period of time), a second operation, such as the reproducing (printing) operation is performed."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *when release switch 101 (or print start switch 214) is manipulated a first time, a first operation (such as, for example, the photography operation) is performed. When the release switch 101 (or print start switch 214) is manipulated a second time (or, alternatively, depressed continuously for a predetermined period of time), a second operation, such as the reproducing (printing) operation is performed*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In re pages 6-7, Applicant argues that the applied art of record does not disclose the feature " after a photographing operation is performed, the operation mode is changed to the reproducing (printing) mode, and a wait state is performed, in which certain operations (such as,

for example, steps 104, 130, 132 and 136, shown in Fig. 5A and 5B) are repeatedly executed (looped)."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *after a photographing operation is performed, the operation mode is changed to the reproducing (printing) mode, and a wait state is performed, in which certain operations (such as, for example, steps 104, 130, 132 and 136, shown in Fig. 5A and 5B) are repeatedly executed (looped)*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, regarding claim 8, the Applicant amended claim 8 with the limitation "wherein a waiting operation is performed in said reproduction mode after said photographing operation is performed." The Examiner considers that Nakamura do disclose this feature. Nakamura discloses a copy switch 17 for causing the printer device 12 to print the stored contents of a memory 16 provided in the printer 12 (column 3, lines 47-55). This clearly shows that there is "a waiting operation" after photographing operation is performed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 16, there is no disclosure to describe the newly added limitation "said photographing operation being performed, in said reproduction mode."

Claims 17-18 are rejected as being dependent on claim 16.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (US 4,942,477).

Regarding claim 1, Nakamura discloses a still video camera (optical device 1, figure 1, column 3, lines 5-10) connectable to a printer (printer 12, figure 1) provided with a printing operation start mechanism (first push-button 13, figure 1, column 3, lines 41-45), comprising an image data generating processor that performs (controller 10, figure 1, column 3, lines 32-35), in a photography mode, a photographing operation in which image data is generated according to said image formed by an optical system (lens 3, figure 1, column 3, lines 17-20); an image data

generating start mechanism (second push-button switch 28, figure 1, column 3, lines 24-28); an image data transmitting processor (controller 10 and signal cable 11, figure 1, column 3, lines 35-42, column 4, lines 13-15) that transmits, in a reproduction mode, said image data to said printer; said image data generating processor being activatable in said photography mode, by said printing operation start mechanism (first push-button 13, figure 1, column 3, lines 41-45); and said image data transmitting processor being activatable, in said reproduction mode by said printing operation start mechanism, so that said printer carries out said printing operation (the first push-button switch 13 determines a timing at which a picture image is to be taken out and instructing the printer device 12 prints a hard copy, figure 1, column 3, lines 24-56).

Regarding claim 2, Nakamura discloses a release switch (second push-button switch 28, figure 1, column 3, lines 24-28).

Regarding claim 3, Nakamura discloses wherein after said photographing operation, an image is printed by the printer (column 3, lines 45-50).

Regarding claims 4 and 12, Nakamura discloses wherein said first operation is a continuous operation over a predetermined period of one of said printing operation start mechanism and said image data generating start mechanism (the second push-button switch 28 determines a timing at which a picture image is to be taken out, figure 1, column 3, lines 24-56).

Regarding claims 5 and 13, Nakamura discloses wherein, in said reproduction mode, said image data is printed by said printer in accordance with a second operation of one of said printing operation start mechanism and said image data generating start mechanism (the first push-button switch 13 instructs the printer device 12 prints a hard copy, figure 1, column 3, lines 40-50).

Regarding claim 6, Nakamura discloses wherein, in said photography mode, said photographing operation is performed in accordance with a second operation of one of said printing start mechanism and said image data generating start mechanism (second push-button switch 28 is used for capturing image, figure 1, column 3, lines 24-28), said reproduction mode (printing operation) being subsequent to said photographing operation (column 3, lines 45-50).

Regarding claims 7 and 14, Nakamura discloses wherein said second operation is a single operation of less than a predetermine period of one of said printing operation start mechanism and said image data generating start mechanism (the second push-button switch 28 determines a timing at which a picture image is to be taken out and instructing the printer device 12 prints a hard copy, figure 1, column 3, lines 24-56).

Regarding claim 8, Nakamura discloses a printer (printer 12, figure 1) connectable to a still video camera (optical device 1, figure 1, column 3, lines 5-10), said printer comprising an image data receiving processor that receives said image data from said still video camera (inherently included in printer device 12, figure 1, column 3, lines 35-41); a printer processor

that prints the image (column 3, lines 40-45); a printing operation start mechanism that activates the printing processor, said still video camera being activatable by said printing operation start mechanism in said photography mode to perform the photographing operation (first push-button 13, figure 1, column 3, lines 24-56), wherein a waiting operation is performed in said reproduction mode after said photographing operation is performed (Nakamura discloses a copy switch 17 for causing the printer device 12 to print the stored contents of a memory 16 provided in the printer 12 (column 3, lines 47-55). This clearly shows that there is "a waiting operation" after photographing operation is performed).

Regarding claim 9, Nakamura discloses wherein said printing processor is activatable, in said reproduction mode, by an image data generating start mechanism (second push-button switch 28, figure 1, column 3, lines 24-28) of an image data generating processor (controller 10, figure 1, column 3, lines 32-35) provided in said still video camera to perform said photographing operation (the second push-button 28 instructs a printing operation, figure 1, column 3, lines 24-28, lines 41-45, lines 51-55).

Regarding claim 10, Nakamura discloses wherein said printing operation start mechanism comprises a print start switch depressable to activate a printing operation (first push-button 13, figure 1, column 3, lines 24-56).

Regarding claim 11, Nakamura discloses wherein, in said photography mode, said photographing operation is performed in accordance with a first operation of one of said printing

operation start mechanism and said image data generating start mechanism (first push-button switch 13 is used for capturing image, figure 1, column 3, lines 40-50), and after said photographing operation, said image data obtained by said photographing operation is printed by said printer (column 3, lines 45-50).

Regarding claim 15, Nakamura discloses an image indicating monitor (indicating device 15, figure 1, column 3, lines 45-48).

Regarding claim 16, all the limitations are contained in claims 1, 3. Therefore, see Examiner's comment regarding claims 1, 3.

Regarding claim 17, see Examiner's comment regarding claims 4 and 7.

Regarding claim 18, see Examiner's comment regarding claim 6.

Regarding claim 19, all the limitations are contained in claim 1. Therefore, see Examiner's comment regarding claim 1.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Luong T Nguyen** whose telephone number is **(703) 308-9297**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber** can be reached on **(703) 305-4929**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to : (703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 whose telephone number is (703) 306-0377.

LN LN
8/09/03

WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600